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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,007	02/17/2004	Kuntal Chowdhury	15927RRUS02U	9570

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CARR LLP
670 FOUNDERS SQUARE
900 JACKSON STREET
DALLAS, TX 75202

EXAMINER

KIM, PAUL

ART UNIT PAPER NUMBER

2161

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,007

Applicant(s)

CHOWDHURY ET AL.

Examiner

Paul Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 31 August 2006.
2. Claims 1-6 and 15-20 are pending and present for examination. Claims 7-14 have been withdrawn.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 27 August 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claim 20** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. **As per claim 20**, it is unclear what the recited claim language is attempting to place a limitation on the logic to extract a domain name from the reverse DNS query. For purposes of this Office action, a prior art rejection will not be applied to claim 20 since it is not readily determinable as to the limitations of the claim language.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-3** are rejected under 35 U.S.C. 102(e) as being anticipated by Chu et al (U.S. Patent No. 6,970,924, hereinafter referred to as CHU), filed on 23 February 1999, and issued on 29 November 2005.

9. **As per independent claim 1**, CHU teaches:

A method of determining an Internet Protocol (IP) address of an application server of a serving network, comprising:

receiving an IP address {See CHU, C16:L7-32, wherein this reads over "[p]erforming a reverse DNS lookup on each IP address"};

performing a reverse domain name query as a function of the received IP address {See CHU, C16:L7-32, wherein this reads over "[p]erforming a reverse DNS lookup on each IP address"};

receiving a response to the reverse domain name query {See CHU, C16:L7-32, wherein this reads over "[p]erforming a reverse DNS lookup on each IP address returns strings representing host names for links (e.g. 208.218.140.5 may map to inverse-gwl.alter.net)"};

deriving serving network domain name information from the reverse domain name query {See CHU, C16:L7-32, wherein this reads over "a router with links names 'host1.inverse.net' and 'host2.alter.net' may be situated on the administrative boundary between 'inverse.net' and 'alter.net'" and "[a] central server, such as the server at whois.internic.net, can be queries for the owner of a given IP address. Whois requests return domain names"};

prefacing an application server name to the derived serving network domain name information {See CHU, C16:L7-32, wherein this reads over "a router with links names 'host1.inverse.net' and 'host2.alter.net'"};

performing a domain name query as a function of the derived serving network domain name prefaced with the application server name {See CHU, C16:L7-32, wherein this reads over "a router with links names 'host1.inverse.net' and 'host2.alter.net' may be situated on the administrative boundary between 'inverse.net' and 'alter.net'" and "[a] central server, such as the server at whois.internic.net, can be queries for the owner of a given IP address. Whois requests return domain names"}; and

receiving an IP address as a function of the derived serving network domain name prefaced with the application server name {See CHU, C16:L7-32, wherein this reads over "[p]erforming a reverse DNS lookup on each IP address returns strings representing host names for links (e.g. 208.218.140.5 may map to inverse-gwl.alter.net)"}.

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10. **As per dependent claim 2**, CHU teaches:

The method of claim 1, wherein the step of receiving an IP address further comprises receiving an IP address for a user equipment (UE) {See CHU, C16:L7-32, wherein this reads over "[b]oundary routers" and "each IP address"}.

11. **As per dependent claim 3**, it would be inherent for the step of receiving an IP address comprised of receiving an IP address associated with a device providing an IP address to the serving network since without the IP address, none of the subsequent steps of the claimed invention would be possible.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 4-6 and 15-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over CHU, in view of Official Notice.

14. **As per dependent claims 4 and 19**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit an IP address of a gateway to the UE since a gateway is well-known and commonly-used within the art to connect two IP-based networks.

15. **As per dependent claim 5**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to derive information from a Uniform Resource Identifier (URI), since a URI is well-known and commonly-used within the art to identify a resource.

16. **As per dependent claim 6**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the application server be a Proxy Call Session

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Control Function (P-CSCF) server name since a P-CSCF server is simply another type of application server available.

17. **As per dependent claim 15**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a system comprise of an access gateway and a DNS associated with the access gateway since an access gateway is commonly-used within networks as a gatekeeper for access to the Internet. Furthermore, the aforementioned reasons for the rejection of claim 1 are incorporated herein.

18. **As per dependent claim 16**, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the serving network to have a URI since a URI is commonly-used and well-known in the art to be used as an identifier of network resources.

19. **As per dependent claim 17**, CHU teaches:

The method of claim 1, wherein the step of receiving an IP address further comprises receiving an IP address for a user equipment (UE) {See CHU, C16:L7-32, wherein this reads over "[b]oundary routers" and "each IP address"}.

20. **As per dependent claim 18**, it would be inherent for the step of receiving an IP address comprised of receiving an IP address associated with a device providing an IP address to the serving network since without the IP address, none of the subsequent steps of the claimed invention would be possible.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Non-Patent Literature, "Gateway (telecommunications)," published on Wikipedia;
- Non-Patent Literature, "Uniform Resource Identifier," published on Wikipedia; and
- Non-Patent Literature, CARON, Jacques, "DNS-based roaming," Internet Draft, April 2002, 5 pages.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Kim
Patent Examiner, Art Unit 2161
TECH Center 2100


SAM RIMELL
PRIMARY EXAMINER